

REMARKS

The Office Action dated December 12, 2007 has been received and carefully noted. The above amendments to the claims, the following remarks, and the attached Declaration under 37 C.F.R. §1.132 are submitted as a full and complete response thereto.

Claims 1-3, 5-14, 16-40, and 42-53 are currently pending in the application, including independent claims 1, 38, 47, and 50-53. More specifically, Applicants herein amended claims 1-3, 5-14, 16-18, 20-24, 26-31, 33, 37-40, and 42-53. It is respectfully submitted that the amendments add no new subject matter to the present application and serve only to place the present application in better condition for examination by more particularly pointing out and distinctly claiming the subject matter that the Applicants regard as the invention. Entry of the amendments and reconsideration of the rejected pending claims are respectfully requested. It is believed that all grounds for rejection in the Office Action have been addressed and that the present application is currently in condition for allowance in view of the amendments and the following arguments. Reconsideration and allowance of claims 1-3, 5-14, 16-40, and 42-53 are respectfully requested.

Claim Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejected claims 1-3, 5-14, 16-40, and 42-53 under 35 U.S.C. §112, Second Paragraph as being patentably indefinite for allegedly failing to particularly

point out and distinctly claim the subject matter that the Applicants regard as the invention. According to the Office Action, the word “either” in independent claims 1, 38, 47, and 50-53 is allegedly patentably unclear. Applicants herein amended claims 1, 38, 47, and 50-53 to address this rejection by deleting this term. Applicants therefore urge that this rejection of claims 1-3, 5-14, 16-40, and 42-53 is in now moot in view of the amendments. Withdrawal of this rejection and reconsideration of claims 1-3, 5-14, 16-40, and 42-53 are therefore respectfully requested in view of the present amendment.

Claim Rejection Under 35 U.S.C. §101

The Office Action rejected claim 51 under 35 U.S.C §101 as being allegedly directed to non-statutory subject matter because claim 51 recited a “computer program.” Applicants have amended claim 51 as suggested in the Office Action to recite “a computer readable medium...” Applicants therefore suggest that this rejection of claim 51 is in now moot in view of the amendment, so withdrawal of this rejection and reconsideration of claim 50 are respectfully requested.

Claim Rejection Under 35 U.S.C. §103(a)

The Office Action rejected all of the presently pending claims under 35 U.S.C. §103(a), as described below.

- Claims 1-3, 5-6, 8-10, 12, 14, 16-17, 19-27, 29-30, 32-40, 42-43, 47-48, and 50-53 were rejected as being obvious in view of U.S. Published Patent Application No. 20040228362 (Maki).

- Claims 7, 11, 13, 18, 28, 31, 45-46, and 49 were rejected as being unpatentable over Maki in view of 3GPP TS 29.207 V5.5.1 (2003-10) (3GPP29.207) and 3GPP TS 33.107 V.6.0.0 (2003-9) (3GPP33.107).

Applicants respectfully traverse these rejections because Maki is not citable prior art in a rejection under 35 U.S.C §103(a) because Maki is assigned to Nokia, the assignee of the present application. Furthermore, as admitted in the Office Action, 3GPP TS 29.207 V5.5.1 (2003-10) (3GPP29.207) and 3GPP TS 33.107 V.6.0.0 (2003-9) (3GPP33.107) by themselves do not disclose each and every limitation of any of the pending claims. Applicants respectfully traverse this rejection and request reconsideration in view of the following arguments.

As previously noted, both Maki and the present application share co-inventors and were assigned to common assignee Nokia Corporation from the times of invention of the subject matters disclosed in both applications. Consequently, since Maki is a published patent application that is allegedly a prior art reference only under 35 USC §102(e), it is legally improper to use Maki in art-based rejections under 35 USC §103(a). For this reason, this rejection is legally traversed, and claims 1-3, 5-14, 16-40, and 42-53 are allowable. Furthermore, if the USPTO subsequently rejects claims 1-3, 5-14, 16-40, and 42-53 on separate grounds, the new rejection must be non-final.

Although this legal fact was raised in the previously submitted Response, the Office Action at page 17 argued that insufficient evidence has been presented to have Maki removed as a citable reference and requested an affidavit in support of the mutual

ownership of Maki and the present application at their times of invention. Under the Manual of Patent Examining Procedures (MPEP) at §§706.02(1)(1)-(3), submission of an affidavit is optional, particularly since assignments to Nokia for both Maki and the present application are recorded at the USPTO and since Mr. Tony Maki is named as a co-inventor in the present application.

Applicants are quite familiar with Maki because Mr. Maki, the first named inventor in Maki, is also named as a co-inventor in the present application. Applicants also note that both the present application and Maki are both being handled by the undersigned representatives.

Applicants note that the art-based rejections are legally improper under 35 USC §103(c)(1) that directs that:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Therefore, 35 U.S.C. §103(c)(1) includes the followings requirements:

1. The rejection is under 35 U.S.C. §103(a);
2. The subject matter (the cited reference) was developed by another person;
3. The subject matter qualifies as prior art only under 35 U.S.C. §§102 (e), (f), or (g); and
4. the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicants, as described below, urge that all of these conditions are currently met, and therefore Maki is not a citable prior art reference against the present application.

Regarding the first requirement, as noted above, in the pending Office Action, all of the art-based rejections alleged that the claims were unpatentably obvious under 35 U.S.C. §103(a).

Regarding the second requirement for 35 U.S.C. 103(c)(1), Maki was developed by “another person.” In particular, under U.S. patent law, an invention is developed by “another person” if the inventors (i.e., the inventive entity) differ by even a single person. *See, for example*, MPEP §2132.

Regarding the third requirement, Maki qualifies as citable prior art only under 35 U.S.C. §102(e), if at all. In particular, Maki is a patent application that published after the filing of the present application and has yet to issue. Moreover, section 4 of the prior Office Action alleged that Maki is a prior art reference under 35 U.S.C. §102(e).

Regarding the fourth requirement, Applicants further note that the claimed invention in the present application and the subject matter of the cited references were owned or under a duty to assign to Nokia at the time of the invention of the present application. As evidence of this ownership, Applicants note that all of the inventors in the present and the cited applications executed assignments to Nokia, and these assignments were recorded in the U.S. Patent and Trademark Office.

Under MPEP §706.02(I)(2), examiners are directed to disqualify a reference under 35 U.S.C. 103(c) only if proper evidence is filed. However, there same section contains the following language:

Applications and patents will be considered to be owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s).

Thus, Applicants' statements in the prior submitted Response asserting joint ownership at the time of invention should have been legally sufficient, and the submission of a supporting Declaration is optional, particularly since assignments to the same Assignee for both Maki and the present application are recorded at the USPTO and since Mr. Maki is named as a co-inventor in the present application and the cited reference.

However, in order to expedite examination, as requested in the Office Action, Applicants herein attached an executed Declaration under 37 CFR §1.132 from an official at the Assignee who indicates that the claimed invention in the present application and the subject matter of the cited references were owned or under a duty to assign to Assignee at the time of the invention of the present application..

Although this rejection is "final" and a Declaration is not ordinarily accepted at this procedural point, Applicants respectfully request the acceptance of the Declaration at this time since it is directed solely to legal, non-technical matters to show that the pending rejections are legally improper. Furthermore Applicants note that the

Declaration is being submitted in response to a direct request in the Office Action and although the Declaration is not required under the MPEP. Therefore, Applicants did not need to submit the Declaration with the prior Response.

For at least these reasons described above, Maki is not a citable prior art reference against the present application.

Furthermore, as discussed below, each of the pending claims currently recites subject matter which is neither disclosed nor suggested in the remaining cited references of either 3GPP29.207 or 3GPP33.107. For example, neither 3GPP29.207 nor 3GPP33.107 relates to Lawful Interception (LI) information and, therefore, these references do not teach or suggest the recitations from claim 1 that “one of a network element and a function of the first network sends Lawful Interception (LI) information directly to one of a support node of the second network, an Administration Function (ADMF), and a Delivery Function (DF).”

Furthermore, neither 3GPP29.207 nor 3GPP33.107 relate to mapping functions and, therefore, the combination does not teach or suggest the recitation in claim 1 that “a Mapping Function is provided which translates target indications of the first network to corresponding target indications of the second network associated with a same monitored user.”

For at least these reasons, the combination of 3GPP29.207 and 3GPP33.107 neither teaches nor suggests each and every limitation contained in independent claim 1. Likewise, independent claims 38, 47, and 50-53, although different in scope from claim

1, recite similar limitations related to lawful interception and mapping and are consequently allowable, along with their dependent claims, over the combination of 3GPP29.207 and 3GPP33.107. Reconsideration and allowance of the pending claims 1-3, 5-14, 16-40, and 42-53 in view of these comments are respectfully requested.

As discussed above, each of the pending claims 1-3, 5-14, 16-40, and 42-53, including independent claims 1, 38, 47, and 50-53 recites subject matter which is neither disclosed nor suggested in the cited references. Applicants submit that the recited subject matter is more than sufficient to render the invention non-obvious to a person of ordinary skill in the art. It is respectfully requested that independent claims 1, 38, 47, and 50-53 and the related dependent claims be allowed in view of the above arguments, comments and remarks and that the present application be allowed to pass to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'David D. Nelson', written over a horizontal line.

David D. Nelson
Registration No. 47,818

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Tysons Corner, Virginia 22182-2700
Telephone: 703-720-7800
Fax: 703-720-7802

Attachments: Petition for Extension of Time
Declaration under 37 C.F.R. §1.132
CkNo. 18560

DDN/cqc